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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,033	03/20/2001	Hiroshi Sasaki	01154/LH	2754
1933	7590	11/21/2006	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			TARAE, CATHERINE MICHELLE	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/813,033

Applicant(s)

SASAKI ET AL.

Examiner

C. Michelle Tarae

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communication received on September 15, 2006. Claims 1-30 have been canceled. Claims 31-43 have been newly added. Claims 31-43 are now pending in this application.

### ***Response to Amendment***

2. The addition of claims 31-43 is acknowledged.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 31-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilz, Sr. et al. (U.S. 6,152,369).

As per claim 31, Wilz, Sr. et al. discloses a marketing research comprising:

distributing a plurality of copies of a printed matter each marked with an optically readable coded image encoding ID information and a URL specifying an information resource on the Internet, wherein the ID information includes information to identify at least one of a name, type, distribution area, data of distribution and purpose of distribution (col. 5, lines 19-29; col. 6, lines 57-67; col. 23, lines 43-55; col. 24, lines 6-21; col. 31, lines 47-51; Figure 7A; Printed matter is distributed such as books, journals,

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magazines, etc. The printed matter includes URL-encoded bar codes that point to information resources on the Internet. The URL-encoded bar code also includes ID information such as title and description. The URL-encoded bar code also supports document tracking and delivery where each printed document is uniquely identified.);

obtaining ID information identifying respective copies of the printed matter and access information for each access to the information resource responsive to an operation of: (i) optically reading with a reading device the optically readable coded image provided on the printed matter, (ii) restoring the URL and the ID information from the read coded image, and (iii) accessing the information resource corresponding to the restored URL via an access device which is connected to the reading device (col. 5, lines 39-53; col. 18, lines 44-67; When a URL-encoded bar code is read, it identifies the location of the information resource on the Internet, restores it and directs a user to the correct URL for access.); and

storing the restored ID information and the access information (col. 31, lines 41-47; Figure 11B; Document ID, tracking and delivery (i.e., access) information is stored and maintained.).

Wilz, Sr. et al. does not expressly disclose producing a marketing research report utilizing the stored ID information and the stored access information. However, Wilz, Sr. et al. does disclose a document tracking system in which each document is uniquely identified and individually tracked (i.e., access is tracked) (col. 5, lines 19-29), thereby illustrating a system that manages the information necessary to produce such a report. Wilz, Sr. et al. also discloses placing trackable URL-encoded bar codes on business

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cards to automatically link customers or potential business associates to certain information resources on the Internet (col. 31, line 64-col. 32, line 5). Additionally, it is old and well known in the art of marketing research to monitor the use/access of distributed marketing materials to determine the effectiveness of the materials in causing a customer/potential customer to take a certain action (i.e., redeem a coupon). Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the system of Wilz, Sr. et al. to produce a marketing research report utilizing the stored ID information and the stored access information in order to track the effectiveness of the printed materials (i.e., the business cards) in causing a customer/potential business associate to take a certain action (i.e., visit the information resource indicated on the business card), thereby enhancing the usefulness of the marketing strategy.

As per claim 32, Wilz, Sr. et al. discloses the marketing research method wherein the URL includes the ID information (col. 5, lines 19-29; col. 17, line 60-col. 18, line 14; col. 31, line 41-col. 32, line 6; The printed matter is identified by the URL. A document tracking and delivery server uniquely identifies each document via the URL.).

As per claim 33, Wilz, Sr. et al. discloses the marketing research method wherein the optically readable coded image further contains a browser starting program for starting a browser for the access device (col. 6, line 57-col. 7, line 24; The bar code symbol may be encoded with a URL as well as with instructions for starting a browser program.).

As per claim 34, Wilz, Sr. et al. discloses the marketing research method wherein said printed matter is one of a newspaper, a magazine, a book, a journal, a pamphlet, a catalog, a leaflet and a ticket (col. 23, lines 47-60; Printed matter may include books, journals, magazines.).

As per claim 35, Wilz, Sr. et al. discloses the marketing research method wherein each copy of the printed matter carries at least one of a plurality of articles and advertisements and the at least one of each article and each advertisement shown on the printed matter is provided with a respective optically readable coded image, and the URL contained in each of the coded images includes ID information for identifying the at least one of the article and the advertisement, whichever appropriate (col. 23, lines 47-60; col. 34, lines 4-8; Multiple URL encoded images may be included on a printed matter. For example, a writer of a book may include lists of URL encoded images identifying the references cited for the book. The URL encoded images may link to advertisements.).

As per claim 36, Wilz, Sr. et al. discloses the marketing research method wherein the information resource is an information resource belonging to the issuer of the printed matter (col. 23, lines 47-67; col. 24, lines 3-26; The composer of the URL encoded images may be the writer of the book and the information resource may be their product/service website. The composer of the URL encoded images may identify any information resource they desire.).

As per claim 37, Wilz, Sr. et al. discloses the marketing research method wherein the plurality of copies of the printed matter contain a same advertisement and the

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advertisement of each of the printed matter is accompanied by a coded image specific to the printed matter, and the information resource is an information resource belonging to a sponsor of the advertisement (col. 31, lines 47-67; col. 34, lines 4-8; The URL encoded images may link to advertisements. The encoded images include a URL for identifying the information resource on the Internet as well as an ID for identifying the printed matter. A document tracking and delivery system is used to track access to the printed matter.).

As per claim 38, Wilz, Sr. et al. discloses the marketing research method wherein the access information on the accesses to the information resource includes at least one of a number of accesses, date and time of each of the accesses and data on each person who accessed the information resource (col. 31, lines 30-67; Figures 7A, 7B and 11B; A document tracking and delivery system is used to track access to the printed matter.).

As per claim 39, Wilz, Sr. et al. discloses the marketing research method wherein the optically readable coded image includes information on at least one of a sound, an image and a text in addition to said URL (col. 31, lines 6-29; The coded images may include multi-media, such as audio-visual messages.).

Claims 40-43 recite limitations similar to the limitations already rejected above in claims 31-39. Therefore, claims 40-43 are rejected on the same basis as claims 31-39 above.

***Response to Arguments***

5. Applicant's arguments are with regard to Wilz, Sr. et al. not teaching the newly added limitation of producing a marketing research report. The arguments are moot in view of the new grounds of rejections provided above.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. Michelle Tarae  
Patent Examiner  
Art Unit 3623

November 20, 2006